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WENDEROTH, LIND & PONACK, L.L.P.

Attn: Joseph M. Gorski

2033 K Street N.W.

Suite 800

Washington DC 20006-1021

MAILED APR 11 2006

In re Application of: HATA et al.

Appl. No.: 10/079,494

Filed: February 22, 2002

For: COMPONENT MOUNTING APPARATUS
AND METHOD

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: DECISION ON PETITION

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This is a decision on the petition filed on July 1, 2005 by which petitioner requests withdrawal of the Restriction Requirement as expressed in the Office Action mailed February 18, 2005. The petition is considered pursuant to 37 CFR 1.181, and no fee is required. The delay in consideration of the petition is regretted.

The petition is granted to the extent indicated below.

Review of the prosecution history shows that:

1. The application filed on February 22, 2002 contained claims 1-20 directed to an apparatus and claims 21-24 directed to a method.

2. On March 1, 2004, the examiner promulgated a requirement for restriction between claims 1 – 20, a component mounting apparatus and claims 21-24, a method for mounting components.

3. On March 26, 2004, applicant elected invention I, claims 1 – 20 directed to the apparatus without traverse.

4. On June 3, 2004 the examiner promulgated a first Office action on the merits of the patentability of elected claims 1 – 20.

5. On December 2, 2004 a response was filed by petitioner which substantively amended claims 1 – 13, cancelled claims 14 – 24 and added claims 25 – 60.

The added claims generally corresponded as follows:

- 25 – 32, 47, 48, 55, 56 directed to an apparatus,
- 33-35, 51, 59 directed to a method (utilizing the same apparatus of claim 1),
- 36-38, 52, 60 directed to a method (utilizing the same apparatus of claim 25),
- 39-42, 53 directed to a generalized method, and
- 43 – 46, 54 directed to a generalized method.

6. On February 18, 2005, the examiner promulgated an Office action under *ex parte* Quayle practice, setting forth a second restriction requirement. The requirement divided method from apparatus under MPEP 806.05(c), setting forth the position that the method claims could be practiced by a materially different apparatus or by hand.

7. On April 14, 2005 petitioner filed a traversal of the second restriction requirement, noting that claims 33 and 36 require the structure of claim 1 and 25 for practice of the method, and posits that since claims 39 and 43 can not be

restricted there from, they must also be examined. No further illumination as to petitioner's position regarding claims 39 and 43 is seen in the traversal.

8. On April 15, 2005 an interview was conducted between the examiner and petitioner where it appears petitioner further submitted his traversal to the second restriction requirement. The examiner remained unconvinced and pointed to MPEP 06.05(e) for support of his position.

9. On June 21, 2005 the examiner promulgated an Advisory action, presumably in response to the April 14, 2005 traversal, essentially reiterating that which was contained in the April 15, 2005 interview summary.

10. On July 1, 2005 petitioner filed a petition for supervisory review of the February 18, 2005 restriction requirement.

11. As the period for response to the February 18, 2005 Quayle/Restriction remained tolling upon petitioner, on July 18, 2005 petitioner filed a response cancelling method claims but authorizing re-insertion of any method claims resultant from this petition decision.

At the onset, it is noted that the restriction from which applicant petitions has never been made final by the examiner. Such is required for consideration of a petition under 37 CFR 1.144. However, as it essentially the same restriction as issued in the March 2004 restriction (same reasons, different claims), and given the extent to which applicant has sought to traverse the second requirement, the petition has been construed as a request for supervisory review of the requirement under 37 CFR 1.181.

Initially, it is noted *ex parte* Quayle practice is described in MPEPE 710.02(b) as follows:

When an application is in condition for allowance, except as to matters of form, such as correction of the specification, a new oath, etc., the application will be considered special and prompt action taken to require correction of formal matters. Such action should include an indication on the Office Action Summary form PTOL-326 that prosecution on the merits is closed in accordance with the decision in *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). A 2-month shortened statutory period for reply should be set.

See also MPEP 714.14. It does not appear that the promulgation of an *ex parte* Quayle action was proper following the amendment dated December 12, 2004, because formal matters such as those described above were not outstanding. The outstanding issue was one of the election of the invention by original presentation/examination: whether the claims as amended (added) were directed to the same invention as that previously elected without traverse, regardless of burden upon the office for examination, or whether the claims as amended contained an invention not previously elected AND presented undue burden upon the office to include into the next examination. It is wholly inappropriate to close prosecution on an applicant while at the same time requiring a selection of invention. For at least this reason, the *ex parte* Quayle action must be vacated.

Turning now to the second restriction requirement, petition sets forth an essentially correct recitation of the reasons why portions of the examiner's second restriction requirement fails. The examiner repeatedly relies upon MPEP 806.05(e) for support of the requirement for restriction. This section states in part:

Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process *as claimed* can be practiced by another materially different apparatus or by hand; or (B) that the apparatus *as claimed* can be used to practice another materially different process.

Each of independent claims 33 and 36 requires “providing...a first mounting head section...and a second mounting head section”. The method claims are limited to the use of a particular structure. It is not seen how the examiner can argue, given the explicit recitation of structure, that the method could be practiced by a materially different structure or by hand. Restriction based upon MPEP 806.05(e), for at least claims 33, 36 and those dependent thereon is unsustainable.

A more appropriate reason for insisting upon restriction lies in MPEP 806.05(h) which states:

A product and a process of using the product can be shown to be distinct inventions if either or both of the following can be shown: (A) the process of using as claimed can be practiced with another materially different product; or (B) the product as claimed can be used in a materially different process. The burden is on the examiner to provide an example, but the example need not be documented. If the applicant either proves or provides a convincing argument that the alternative use suggested by the examiner cannot be accomplished, the burden is on the examiner to support a viable alternative use or withdraw the requirement.

This type of restriction requirement includes conditions for rejoinder of invention, once examination has identified an allowable elected apparatus. Noting the conditions for rejoinder as set forth in pertinent section of the MPEP:

when the examiner has required restriction between product and process claims and applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

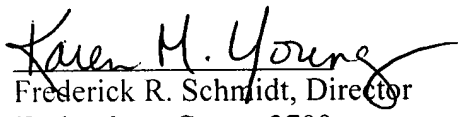
Looking at added method claims 33 and 36 it appears as though they have been drafted in accordance with the guidelines set forth in MPEP 806.05(h) related to product and process of using with respect to rejoinder. It appears as though petitioner felt confidence in the allowability of claims 1 and 25 thus presenting equivalent method claims requiring the allowable structure for practice of the method in rejoinder of the invention.

Petitioner did not, however, include these structural limitations into method claims 39 – 46, 53 and 54. These claims basically re-present subject matter of a scope equivalent to original claims 21 –24, non-elected without traverse. Rejoinder of these claims with the elected and examined invention remains inappropriate.

In summary, the restriction requirement set forth February 18, 2005 is unsustainable under MPEP 806.05(e). The issuance of said requirement within the limited application of ex parte Quayle practice is wholly inappropriate and against Office practice. The appropriate grounds of restriction in the instant application fall under MPEP 806.05(h) and restrict out claims 39 – 46, 53 and 54 as either 1) being directed to an invention non-elected without traverse from the first requirement for restriction or 2) not having the corresponding structure to warrant rejoinder under MPEP 806.05(h). Accordingly, claims 33-38, 51, 52, 59 and 60 are appropriate for rejoinder and claims 39 – 46, 53 and 54 remain subject to a non-final restriction requirement.

As all other issues appear resolved and petitioner has given permission to re-instate a different group of method claims by examiner's amendment, in order to expedite prosecution it is suggested that the examiner contact petitioner to finalize approval of an examiner's amendment consistent with the decision herein and gain authorization to cancel claims 39 – 46, 53 and 54. Should petitioner desire to request reconsideration of this decision or to challenge the proposed basis for alternative restriction set forth herein, he should indicate such to the examiner when contacted as the appropriate next course of action would be to formally vacate the prior ex parte Quayle action and issue a restriction requirement as outlined hereinabove.

PETITION GRANTED-IN-PART

for 
Frederick R. Schmidt, Director
Technology Center 3700